

Remarks/Arguments:

This response accompanies a request for continued examination. Upon entry of the amendments submitted herewith, claims 1-6 and 8-17, 19-36, 48-50, and 52-62 will be pending in the application. Claims 7, 18, 37-47, and 51 are canceled herein, without prejudice or disclaimer. Claims 1, 26, and 49 are amended herein, as supported by claim 7 and the specification, for example, at page 8 lines 19-22. Claims 52-62 are newly added as supported throughout the specification, for example, page 13, lines 15-33. No new matter has been added by way of the claim amendments or new claims.

Interview Summary

Applicants thank the Examiner for the time and courtesies extended to Applicants' representatives during a telephonic interview on August 27, 2008. During the interview, the rejection of the claims over the Schacht patent was discussed along with claim amendments to advance the prosecution of this application, which the Examiner agreed to consider.

Maintained Anticipation Rejection Over U.S. Pat. No. 6,458,386 to Schacht

The Office Action maintained the anticipation rejection on the grounds that Schacht teaches that its matrices can be microparticles (citing column 6, line 42 bridging column 7, line 16). Applicants traverse the rejection because the reference does not teach or suggest all of the limitations of the invention, and does not teach or suggest the elements arranged or combined in the same way as in the claims.

The amended claims recite particles comprising a complex of a bioactive agent joined to a complexing agent with the particle having a diameter from about 1 nm to about 1000 microns, about 15 nm to about 100 microns, and about 150 nm to about 220 nm. Schacht does not teach or suggest particles of these sizes. Although the reference describes *theoretical* microparticles, there is no mention of what size the particles can be, and there is no teaching of how to make microparticles of the claimed size.

In a recent decision from the Federal Circuit, the Court clarified the test for anticipation. *Net MoneyIn Inc. v. Verisign, Inc.* ____ F.3d ____ (Fed. Cir. 2008). The Court explained that it is not sufficient that the claimed elements can be found within the four corners of a reference. Rather, it is required that the reference "must show all of the limitations of the claims arranged or combined in the same way as recited in the claims." This is because the "hallmark of anticipation is prior

invention." The Court held that the test for anticipation is whether the reference describes the claimed elements "arranged or combined in the same way as in the claim."

In this case, the burden on the Office is to show that Schacht teaches or suggests particles having the claimed sizes. The Office has not met this burden. Because Schacht's microparticles are theoretical, and the reference gives no guidance as to what size they could be, it is clear that this reference does not describe the claimed elements arranged in the same way as in the amended claims. For these reasons, the rejection lacks proper foundation, and should be withdrawn.

Applicants request reconsideration and withdrawal of the rejection in light of the amendments and arguments presented. Applicants submit that the claims are in condition for allowance, and an early Notice of Allowance is respectfully requested.

Respectfully submitted,



Christopher A. Rothe, Reg. No. 54,650
Brian A. Cocca, Ph.D., Reg. No. 58,583
Attorneys for Applicants

CAR/BAC/lmg
Dated: November 14, 2008

P.O. Box 980
Valley Forge, PA 19482
(610) 407-0700

The Director is hereby authorized to charge or credit Deposit Account No. **18-0350** for any additional fees, or any underpayment or credit for overpayment in connection herewith.